UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/298,538	04/22/1999	FRANCIS JAMES CANOVA, JR.	15886-210	2146

29989 7590 02/08/2005

HICKMAN PALERMO TRUONG & BECKER, LLP
2055 GATEWAY PLACE
SUITE 550
SAN JOSE, CA 95110

EXAMINER	
NELSON, ALECIA DIANE	

ART UNIT	PAPER NUMBER
2675	

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/298,538	CANOVA, ET AL.	
	Examiner	Art Unit	
	Alecia D. Nelson	2675	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,6,16,26,29,30 and 32-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1,6,16,26,29,30 and 32-35* is/are allowed.

6)☒ Claim(s) *36-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. **Claim 36** is rejected under 35 U.S.C. 103(a) as being unpatentable over Samuels (U.S. Patent No. 5,270,821) in view of Reber (U.S. Patent No. 6,002,948) and Kawasugi (U.S. Patent No. 5,703,616).

With reference to the claim Samuels teaches a method and apparatus for adjusting levels of viewing parameters for an image screen (see abstract) comprising; receiving an activation signal for viewing a parameter control from a

first input mechanism (see column 11, lines 21-57), in response to receiving the activation signal, displaying one or more graphical user interface elements (see column 4, lines 12-25) wherein within the main menu a smaller value indicator graph graphically represents the increments and decrements made by the user to a given display parameter, such as brightness (see column 6, lines 26-31).

Even though Samuels teaches that the method is applicable to a wide range of video display devices including CRTS, LCDs, and electro-luminescent displays wherein it is well known for these display devices to include a touch panel surface, there is no disclosure that the video display device is a PDA, the ability to receive user input on the image screen to manipulate the user interface, or the usage of a user operational mechanical button disposed on the PDA for launching the GUI on the image screen.

Reber et al. teaches an input device to receive user-initiated commands. The input device includes a touchpad (10), which recognizes a location of a pointing member on its surface and generates a signal representative of the location (see column 1, lines 34-40). The signals representative of user-initiated commands are communicated from the touch pad (10) to a controller (16), which includes a processor for processing commands in accordance with a predetermined control logic (see column 2, lines 58-68). Associated with the touchpad are images (26, 30), wherein image (30) provides icons for receiving computer-related commands and/or navigation commands (see column 3, lines 28-51). With reference to another embodiment as illustrated in Figure 6, the handheld device includes scroll keys (144), wherein it is also taught that user-

initiated commands and/or navigation commands are received by the touch pad (10). It is also taught the usage of touchpad to enter stroke movements for entering telephone commands as illustrated in Figure 7, thereby teaching detecting continuous contact on the image screen. Further it is taught that the input device as described could be represented as a personal digital assistant (see column 13, lines 26-34).

Kawasugi describes a PDA (11) having a display section (12), which is covered with a transparent touch panel (14), wherein a display contrast volume (18) is operated for adjusting the contrast on the liquid crystal display section (12).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to allow the usage of a PDA including a mechanical button for providing commands to the device when the buttons are activated allowing for manipulations to be carried out by graphical user interfaces being displayed as taught by Reber et al. and Kawasugi, as the video display device allowing for adjustments of viewing parameters as taught by Samuels in order to thereby provide the users of PDA's a method and apparatus which allows adjustment of contrast and brightness parameters easier through usage of the graphical user interfaces disposed on a touch panel display.

3. ***Claims 37 and 38*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Samuels in view of Reber et al. in view of Kawasugi as applied to **claim 36** above, and further in view of Carroll et al.

With reference to **claims 37 and 38,** Samuels, Reber et al., and Kawasugi teach all of the limitations as recited in **claim 36.** However, the references fail to specifically teach a portable device being in a lower power state until any one of a plurality of input mechanisms. is actuated, and there after, switching the computer to a higher power state.

Carroll et al. teaches the usage of a keyboard on-off button, which is represented on the touch screen itself, but also possibly on the housing of the touch screen (see column 4, lines 25-31). Further, Carroll et al. teaches that in a alternate embodiment, voice commands can also be used to activate the touch screen itself so that the portable device does not turn on by one of the buttons being pressed accidentally (see column 11, lines 43-45). Thereby it is suggested that pressing any one of a plurality of input mechanisms on the touch display of the portable device will change the power state from a lower power state (off) to a higher power state (on).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to allow the usage of a low powered state, as taught by Carroll et al. to that which is taught by Samuels, Reber et al., and Kawasugi to thereby reduced in the amount of necessary power when the portion of the pixels are inactive.

Allowable Subject Matter

4. ***Claims 1, 6, 16, 26, 29, 30, and 32-35*** are allowed.

Response to Arguments

5. Applicant's arguments filed 9/10/04 have been fully considered but they are not persuasive. The applicant argues with reference to ***claim 36***, that there fails to be any motivation to combine the teachings of Reber and Kawasugi to the teachings of Samuels. However, the teachings of Samuels does include that the device is operable on a wide variety of display device (see column 2 lines 12-16), and it is well known to those skilled in the art the usage of touch panel surfaces with these types of display devices. Further while Samuels fails to teach any motivation to add touch screen input capability to the display device, the teachings of a wide variety of display device would also include a touch panel display device. The usage of Reber and Kawasugi thereby is used in combination with the teachings of Samuels to explain further details or capability of a conventional touch panel device, wherein it is known by those skilled in the art that the usage of a touch panel device as opposed to a cursor control device is to provide a more convention and direct control method for user input. Therefore the rejection to the claims will be maintained and the rejection made final.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alecia D. Nelson whose telephone number is (703) 305-0143. The examiner can normally be reached on Monday-Friday 9:30-6:00.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMR A. AWAD
PRIMARY EXAMINER

adn/ADN
February 4, 2005